

## **REMARKS**

Claims 7-27 and 58, 59, 61-63, and 65-75 remain in this application. Claims 28-57 have been withdrawn. Claims 1-6, 60, and 64 have been canceled.

The examiner has acknowledged that claims 7-27 and 70-75 are directed to allowable subject matter. Claims 28-57 have been withdrawn as the result of an earlier restriction requirement.

In view of the examiner's earlier restriction requirement, the applicants retain the right to present claims 28-57 in a divisional application.

### **I. CLAIM REJECTIONS – 35 USC § 102**

#### **A. Examiner's Statements**

The examiner rejected claims 1-4 and 58-62 under 35 U.S.C. § 102(b) as being anticipated by Misselbrook et al. (U.S. Patent No. 5,984,011).

#### **B. Law**

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.<sup>1</sup> The identical invention must be shown in as complete detail as is contained in the ... claim.<sup>2</sup> To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."<sup>3</sup> Thus, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic.<sup>4</sup> In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.<sup>5</sup> In addition to disclosing every claim limitation, an anticipatory prior art reference must enable the practice of the invention and

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<sup>1</sup> *Verdegal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

<sup>2</sup> *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

<sup>3</sup> *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

<sup>4</sup> *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993).

<sup>5</sup> *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

describe it sufficiently to have placed it in the possession of a person of ordinary skill in the field of the invention.<sup>6</sup>

### **C. Claims 1-4 and 58-62**

Claims 1-4 have been canceled.

Similarly to the allowed claim 7, claims 58-62 of the present application require diverting a portion of the fluid with a diverter away from the drilling assembly into the deviated wellbore at a flow rate corresponding to a velocity sufficient to remove cuttings while the drilling assembly drills the deviated wellbore. The claims also require expending a pressure differential as said diverted fluid flows through a dissipater. Misselbrook et al., however, only teaches ceasing drilling, opening a valve, and increasing the flow rate to a critical level to bypass the drilling motor and sweep out any cuttings that have accumulated in the wellbore while the drilling is ceased. Thus, Misselbrook et al. does not teach or suggest diverting fluid with a diverter and expending a pressure differential with a dissipater as the diverted fluid flows through the dissipater. Misselbrook et al. therefore does not teach or suggest all of the limitations of the claims. The applicants therefore respectfully submit that the rejection is unsupported by the art and request that the examiner withdraw the rejection with respect to claims 58-62.

## **II. ALLOWABLE SUBJECT MATTER**

The examiner stated that claims 7-27 and 70-75 are allowed.

The examiner stated that claims 5, 6, and 63-69 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The applicants have canceled claims 5, 6, and 64.

The applicants respectfully submit that claims base claim 58 is in condition for allowance as discussed above. Therefore, the applicants respectfully request that the examiner remove the objections to claim 63.

The applicants respectfully point out that claims 65-69 are dependent on allowed based claim 7. As such the applicants respectfully request that the examiner remove the objection to claims 65-69.

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<sup>6</sup> *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

### **III. ALLOWABLE GENERIC CLAIMS/REJOINDER OF WITHDRAWN CLAIMS**

The examiner issued a restriction requirement in the present application dated March 16, 2005. The applicants elected claims 1-27 and 58-75 without traverse. However, the applicants respectfully requested that at least the independent claims 1, 7, and 58 be recognized as generic claims linking various species claims. The applicants submitted that the broadly drafted independent claims 1, 7, and 58 each read on the Figures identified by the examiner as corresponding to Species (1) through (7), which depict various embodiments of an apparatus for removing cuttings from a deviated well bore, and component parts thereof. In addition, the applicants submitted that, because these claims 1, 7, and 58 are independent, they necessarily include no material element additional to those recited in the species claims.

In the first office Action dated July 27, 2005, the examiner agreed, recognizing claims 1, 7, and 58 as generic claims. However, in the first Office action, the examiner rejected claims 1, 7, and 58. With no allowable, generic claims, the examiner did not rejoin the withdrawn claims.

As at least generic claim 7 has now been allowed, and the applicants submit that generic claim 58 is also allowable, the applicants request rejoinder and allowance of the withdrawn claims 28-57.

### **IV. STATEMENT REGARDING CLAIMS**

The applicants have argued the allowability of the claims by addressing the comments by the examiner in this paper as well as previously during the prosecution of this application. By doing so, the applicants are in no way limiting their ability to argue additional points of novelty regarding the independent claims or dependent claims at a later date.

### **CONCLUSION**

The applicants respectfully request reconsideration the pending claims and that a timely Notice of Allowance be issued in this case. If the examiner feels that a telephone conference would expedite the resolution of this case, he is respectfully requested to contact the undersigned.

In the course of the foregoing discussions, the applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. There may also be other distinctions between the claims and the prior art that have yet to be raised, but that may be raised in the future.

Unless the applicants have specifically stated that an amendment was made to distinguish the prior art, it was the intent of the amendment to further clarify and better define the claimed invention and the amendment was not for the purpose of patentability. Further, although the applicants may have amended certain claims, the applicants have not abandoned its pursuit of obtaining the allowance of these claims as originally filed and reserves, without prejudice, the right to pursue these claims in a continuing application.

If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Conley Rose, P.C. Deposit Account Number 03-2769 (ref. 1391-28401) of Conley Rose, P.C., Houston, Texas.

Respectfully submitted,  
CONLEY ROSE, P.C.



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Collin A. Rose  
Reg. No. 47,036  
P.O. Box 3267  
Houston, TX 77253-3267  
(713) 238-8000 (Phone)  
(713) 238-8008 (Fax)